

## **REMARKS/ARGUMENTS**

Claims 17, 19, 20, 22-30, 32 and 33 are pending in this application. Claims 1-16 and 18 were previously cancelled. Claims 21 and 31 are cancelled in this amendment. Claims 17, 19, 20, 22-24, 30, 32, and 33 are currently amended.

### **Amendment to the Title and Specification**

The title and specification were amended in the Preliminary Amendment dated October 11, 2005. The Preliminary Amendment is listed and can be found in the file history on the PAIR system. However, the amendment to the title has not been entered into the bibliographic information for this case. In addition, the amendments to the title and specification were not included in the corresponding published application, No. 2006-0263482 A1. The same amendments to the title and specification are repeated in this amendment for convenience. Applicants respectfully request that the amendments originally made in October 11, 2005 be entered into this case.

### **Claim Rejections -- 35 USC §112**

*Claims 17 and 19-33 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The claims were rejected as being “vague as to how the food and/or beverage is made.” Applicants respectfully maintain that someone skilled in food and beverage production would have many well known means at their disposal for using the malt sprouts immersion liquid produced according to the present application. Nonetheless, applicants have revised these claims to explicitly state that the immersion liquid is used as an ingredient. These amendments are not in response to the prior art.

The Examiner questioned how the same method steps could lead to a production of food and beverage at the same time. Applicants respectfully suggest that one skilled in the art would know of many alternative uses for the immersion liquid as claimed; see page 12, lines 13-26 of the application as filed for some of the possible food and beverage products that can be produced using the immersion liquid described by applicants. Once the

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Amendment dated July 21, 2010

Reply to Final Office Action dated February 22, 2010

immersion liquid is produced, it can be used in either the production of a food or a beverage; or, a given batch of immersion liquid can be divided into two or more portions. One portion can then be used to produce a food product, while the other portion(s) is used to produce a beverage and vice versa.

Applicants submit that this Amendment After Final Rejection places this application in condition for allowance by amending claims in manners that are believed to render all pending claims allowable over the cited art and/or at least place this application in better form for appeal. This Amendment is necessary because the 112 rejection and was not earlier presented because Applicant believed that the prior response(s) placed this application in condition for allowance, for at least the reasons discussed in those responses. Accordingly, entry of the present Amendment, as an earnest attempt to advance prosecution and/or to reduce the number of issues, is requested under 37 C.F.R. §1.116.

In the event that the Office declines to enter the present Amendment, and (i) any portion of the present Amendment would place some of the claims in better form for appeal if a separate paper were filed containing only such amendments or (ii) any proposed amendment to any claim would render that claim allowable, Applicant respectfully requests that the Office inform Applicant of the same pursuant to MPEP §714.13.

### **Claim Rejections -- 35 USC §102**

*Claims 17, 19-20, 24-26 and 29-31 are rejected under 35 U.S.C. §102(b) as being anticipated by Todorova et al.*

On page 3 of the Office Action, the Examiner states that the “uncrushed malt sprouts disclosed by Todorova et al. meet applicant’s definition of having controlled particle size, and thus Todorova’s uncrushed malt sprouts would also inherently read on a “controlled particle size”. In regard to claim 31 and 19, Todorova et al disclose a process for producing beverage product comprising the further step of immersing the malt sprouts in a liquid to allow components of the malt sprouts to seep out into the liquid and further removing the malt sprouts after the immersion step during the soluble extract preparation (p.17).”

Applicants respectfully disagree; Todorova neither discloses uncrushed malt sprouts nor an immersion step. The abstract does not disclose whether the malt sprouts were whole, crushed or ground before extraction, does not disclose how the water soluble extract of malt sprouts was produced, and does not describe removing the malt sprouts.

The entire abstract reads as follows:

#### SUMMARY

Malt sprouts are the main waste from malt production.

The possibilities for producing water soluble extract of malt sprouts and for its following concentration were studied. It was found that the extract had high amino acid, metal ion, phosphorous and vitamin B<sub>1</sub> concentration.

Laboratory experiments were made using the extract of malt sprouts to replace part of the malt extract in beer must. This provided possibilities for balancing beer must composition in regard to amine nitrogen content and other components.

Since the extract of malt sprouts is being used to replace part of the malt extract in beer must (wort?), it is very possible that the malt sprouts were crushed as part of the process. Crushing is generally part of the malted barley or malt extract process. See, for example, Appendix “What is Malt” from How to Brew by John Palmer. Nothing from the abstract explains whether or not the malt sprout extract was produced from ground, crushed, partially crushed or uncrushed sprouts. The abstract is completely silent on this point.

The abstract is also completely silent as to how the water-soluble extract is produced. All that the abstract says is: “The **possibilities** for producing water soluble extract of malt sprouts and for its following concentration were studied.” (Emphasis added.) Nothing in the abstract explains what those possible methods were. There is no reason to think either immersion (claim 32) or immersion in a water-based liquid (claim

33) was used. A water-soluble extract can be produced without using water and without using an immersion process. For example, Japanese Patent Laid-Open Publication No. Hei 3-49662 describes food and beverage products containing water-soluble dietary fiber obtained by extracting malt sprouts with alkali and enzymatically treating the extract. See page 2, lines 4-9 of the present application as filed.

The abstract also is silent with regard to removing the malt sprouts after the immersion step.

On pages 3 of the Office Action, the Examiner suggests that Todorova et al. discloses the controlled size of the malt sprouts. As can be seen above, the abstract reproduced above does not discuss the size of the sprouts.

On page 4 of the Office Action, the Examiner relies on Table 3 of Todorova. Table 3 is clearly not part of the abstract. Only an English language abstract has been provided to the applicants. A translation of Table 3 has not been provided to the applicants so the reliance on Table 3 is completely inappropriate.

Claims 24-26 and 29 are discussed on page 5 of the Office Action. These claims are all dependent on claim 32 as presently amended. The Todorova et al. abstract for the reasons discussed above does not anticipate dependent claims 24-26 and 29 nor independent claims 32 and 33.

As stated in MPEP § 706.02 II:

When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document.

...

If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection.

...

In limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and translation (if not in English) may be supplied in the next Office Action. ... (Emphasis added.)

In both Office Actions, the Examiner has improperly made assertions that do not appear in the Todorova et al. abstract. Applicants respectfully request these rejections be withdrawn. If these rejections are to be continued, applicants request that the Todorova et al. reference be translated in full and the time for response be restarted from the date the translation is mailed. A translation of the full reference was never provided to applicants.

### **Claim Rejections -- 35 USC §103**

*Claims 21-30 and 32-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Todorova, et al. in view of Yamamoto (JP 09-084540).*

Pending independent claims 32-33 all require less than 60wt% of the smaller size particles (150  $\mu\text{m}$ ). The claims require at least 40% of the larger size particles, namely, uncrushed or slightly crushed sprouts. This is exactly opposite the teaching the Yamamoto et al reference. Yamamoto et al. recommend “to finely crush the crushed and sieved malt roots.” See the Yamamoto abstract. Example 2, paragraph [0011] of Yamamoto suggests that **all** of the particles be 100  $\mu\text{m}$  or less, which is definitely teaching away from the invention as taught and claimed in the present invention. Yamamoto suggests including the byproducts of cleaning the barley, such as the hull, cereal husks and ear stems. See abstract and paragraph [0006]. Yamamoto clearly does not suggest immersing the malt roots in a liquid. Rather, the Yamamoto et al. reference suggests using the finely ground barley and byproducts as a “flour” to create various foods. The teaching of this reference is quite unrelated to the claims of the present application.

As discussed above, the abstract of Todorova et al. does not disclose the use of whole malt sprouts nor immersing the malt sprouts in liquid. The combination of the abstract of Todorova et al and the Yamamoto et al reference does not suggest or teach the method claimed in any way. The claims as amended are unobvious over these references. Since the amendments place the claims in position for allowance, applicants respectfully request that they be entered.

**CONCLUSION**

If the Examiner has any questions or suggested Examiner's amendments, the Examiner is respectfully requested to call the undersigned.

The Commissioner is hereby authorized to charge any additional fees, or to credit any overpayment, to Deposit Account No. 50-3195.

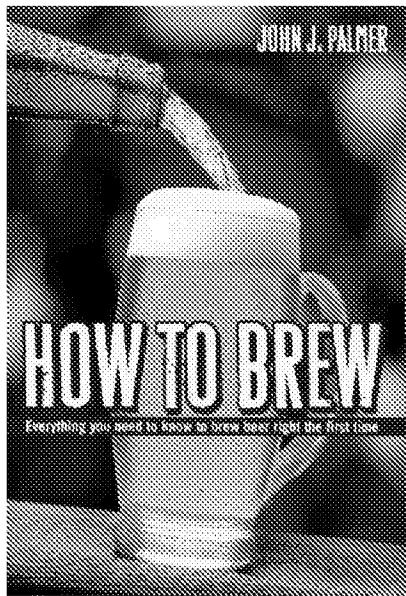
Respectfully submitted,

Date: July 21, 2010

/Manette Dennis/

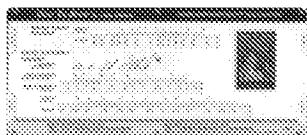
Manette Dennis (Reg. No. 30,623)  
Ostrager Chong Flaherty & Broitman P.C.  
570 Lexington Avenue, Floor 17  
New York, NY 10022-6894  
Tel.: 212 681-0600  
Fax: 212 681-0300  
mdennis@ocfblaw.com

Appendix  
What is Malt -- from How to Brew by John Palmer



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by John Palmer

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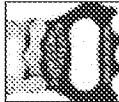
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# HOW TO BREW - BY JOHN PALMER

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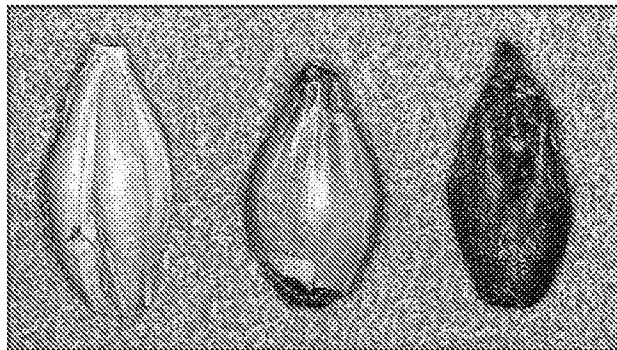
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## Chapter 3 - Malt Extract and Beer Kits

### What is Malt?



Beer is brewed from malted barley. More precisely, beer is made by fermenting the sugars extracted from malted barley (mostly maltose). Malt is a general term used as an abbreviation for several things associated with maltose and malted barley. Brewer's malt is not Malted Milk Balls, Malted Milk Shakes, nor is it malt extract. In those cases, malt refers to the use of maltose - the sugar. The malts that brewers talk about are the specific types of malted barley that are processed to yield a wide range of fermentable maltose sugars. These include Lager Malts, Pale Malts, Vienna Malts, Munich Malts, Toasted, Roasted and Chocolate Malts. But what is malted barley?

Malting is the process in which barley is soaked and drained to initiate the germination of the plant from the seed. When the seed germinates, it activates enzymes which start converting its starch reserves and proteins into sugars and amino acids that the growing plant can use. The purpose of malting a grain is to release these enzymes for use by the brewer. Once the seeds start to sprout, the grain is dried in a kiln to stop the enzymes until the brewer is ready to use the grain.

The brewer crushes the malted barley and soaks it in hot water to reactivate and accelerate the enzyme activity, converting the barley's starch reserves into sugars in a short period of time. The resulting sugar is boiled with hops and fermented by the yeast to make beer.

When making malt extract, the sugar solution is drawn off, pasteurized, and run into vacuum chambers for dehydration. By boiling off the water under a partial vacuum, the wort sugars are not caramelized by the heat of full boiling and a lighter tasting extract is produced. To make a hopped extract, Iso-Alpha Acid extracts of hops are added along with hop oils to give a complete hop character to the final wort extract. These hop extracts are added at the end of the process to prevent loss during dehydration. Malt extract takes a lot of the work out of brewing.

Malt extract is sold in both liquid (syrup) and powdered forms. The syrups are approximately 20 percent water, so 4 pounds of Dry Malt Extract (DME) is roughly equal to 5 pounds of Liquid Malt Extract (LME). DME is produced by heating the liquid extract and spraying it from an atomizer in a heated chamber. Strong air currents keep the droplets suspended until they dry and settle to the floor. DME is identical to LME except for the additional dehydration and lack of hopping. DME is not hopped because hop compounds would be lost during the final dehydration.



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